Hearing: Paper No. 48
June 22, 2000 BAC
11/4/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Symetrix, Inc.
v.
Lucid Corporation, by change of name from Portable Computer Support Group, Inc.[1]

Cancellation No. 24,639

KiSong Kim Lang-Caditz and Kevan L. Morgan of Christensen O'Connor Johnson Kindness, PLLC for Symetrix, Inc.

Thomas A. Roberts of McGlinchey Stafford, PLLC for Lucid Corporation, by change of name from Portable Computer Support Group, Inc.

Before Simms, Chapman and Wendel[2], Administrative Trademark Judges.
Opinion by Chapman, Administrative Trademark Judge:

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[1] In a Board order dated January 11, 2000, the parties were advised that the defendant portion of the caption of this proceeding had been changed to reflect respondent's change of name. [The original registrant, Axon Development Corporation (a Canadian corporation) assigned the registration to Portable Computer Support Group, Inc. (a Texas corporation) in 1988, and the change of name from Portable Computer Support Group, Inc. to Lucid Corporation was recorded with the Assignment Branch of this Office in 1997.]

[2] Administrative Trademark Judge Wendel has been substituted for Administrative Trademark Judge McLeod, who was on the panel at the oral hearing but left government service before the case was decided. See In re Bose Corporation, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985); and Jockey International, Inc. v. Bette Appel Unltd., 216 USPQ 359 (TTAB 1982). See also, TBMP §§802.04 and 803.

Symetrix, Inc. has filed a petition to cancel Registration No. 1,433,593 on the Principal Register for the

mark LUCID for "computer programs."[3]

As grounds for cancellation petitioner alleges that it "has a bona fide intention to use the trademark LUCID in conjunction with the sale of computer software in the broadcast, video, film and music industries"; that respondent has never used the mark LUCID "in conjunction with the sale of computer software in the broadcast, video, film or music industries"; that to the extent respondent ever owned any rights to the mark LUCID in conjunction with the sale of computer software in the broadcast, video, film and music industries, respondent has abandoned those rights as respondent "has never used the mark to identify software sold in those industries"; that respondent has not used the mark LUCID in conjunction with the sale of computer software in the broadcast, video, film and music industries for a period in excess of three years; and that respondent has abandoned the mark LUCID for "computer software in the broadcast, video, film and music industries" (petition to cancel, paragraphs 4, 5, 7 and 8).

[3] Registration No. 1,433,593 issued March 24, 1987, under Sections 44(d) and (e) of the Trademark Act based on a Canadian application, and subsequently, a Canadian registration; Section 8 affidavit accepted, Section 15 affidavit acknowledged.

Petitioner requests that the registration be cancelled in its entirety, or in the alternative, that it be partially cancelled.

Respondent, in its answer, denies the salient allegations of the petition to cancel.

The record consists of the pleadings[4]; the file of the involved registration[5]; and petitioner's notice of reliance filed October 16, 1998.[6] On April 27, 1999, respondent formally advised the Board and petitioner that it "intentionally elected not to take any testimony or file any Notices of Reliance on any evidence" during its testimony period. Consequently, petitioner offered no rebuttal evidence. Both parties filed briefs on the case.[7] Only petitioner's attorney attended the oral hearing before this Board.

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[4] Statements made in pleadings cannot be considered as evidence in behalf of the party making them; such statements must be established by competent evidence during the time for taking testimony. See Kellogg Co. v. Pack'Em Enterprises Inc., 14 USPQ2d 1545 (TTAB 1990), aff'd, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); and Times Mirror Magazines, Inc. v. Sutcliff, 205 USPQ 656 (TTAB 1979). See also, TBMP §706.01.

[5] Informationally, the parties are advised that the file of the involved registration is of record to the extent provided in Trademark Rule 2.122(b)(1).

[6] The paper titled "Clarification of Information Presented at Oral Hearing" filed by petitioner on July 17, 2000 is not evidence in this case.

[7] Factual statements made in briefs on the case can be given no consideration unless they are supported by evidence properly introduced at trial. See BL Cars Ltd. v. Puma Industria de Veiculos S/A, 221 USPQ 1018 (TTAB 1983); and Abbott Laboratories

The entire evidentiary submission by petitioner consists of petitioner's notice of reliance, filed October 16, 1998, on the following three named items[8]:

(1) respondent's responses to petitioner's first set of interrogatories (Nos. 1-11);

(2) respondent's combined responses to petitioner's second set of interrogatories (Nos. 1-2), request for production of documents (No. 1) and first set of requests for admission (Nos. 1-2); and

(3) "the record of pleadings and orders issued in this matter to date."[9]

Petitioner bears the burden of proof in this case, and must establish both its standing and any pleaded ground by a preponderance of the evidence. See Cerveceria Centroamericana, S.A. v. Cerveceria India Inc., 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989). See also, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §20:41 (4th ed. 2000).

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v. TAC Industries, Inc., 217 USPQ 819 (TTAB 1981). See also, TBMP §706.02.

[8] Respondent's answers to discovery included several documents which petitioner submitted with this notice of reliance. (ftnt cont.) Normally documents produced by the adverse party are not admissible by way of a notice of reliance. See Trademark Rule 2.120 (j)(3)(ii); and TBMP §711. However, in this case, respondent made no objection thereto. Accordingly, we have considered the documents produced by respondent and submitted by petitioner with its notice of reliance.

[9] We remind the parties that by order dated January 11, 2000 the Board granted respondent's motion to strike that portion of petitioner's notice of reliance relating to the pleadings, but we also explained any possible evidentiary value of the pleadings. (See January 11, 2000 Board order, pp. 2-3).

It is not sufficient to plead standing; rather, the factual allegation(s) which establish standing must be affirmatively proved. See Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); and Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Petitioner submitted no evidence of any type relating to its standing to bring this petition (e.g., testimony of petitioner, a notice of reliance on a copy of a pending application owned by petitioner, a current status and title copy prepared by the PTO of a federal registration owned by petitioner). Therefore, petitioner has failed to prove its standing.

Regarding the ground for cancellation of the registration (in whole or in part), petitioner pled only abandonment in the petition to cancel. Further, petitioner argued in both its brief and reply brief (e.g., brief, p. 6, and reply brief, pp. 4-5.) that the issue before this Board is abandonment, not likelihood of confusion as contemplated in the case of Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG, 34 USPQ2d 1266 (TTAB 1994).[10]

[10] Respondent argued in its brief on the case that petitioner has not stated a valid claim for partial cancellation under the Eurostar case. Whether this case is viewed as one based on a

Petitioner essentially contends that the evidence establishes that respondent uses its mark LUCID on computer programs that generate spreadsheets, function as desktop and personal information managers and perform computer utility functions; that the scope of respondent's rights is limited to the particular goods on which it has used its mark; that respondent "has not shown any use of the mark LUCID on software specifically designed for sale and use in the broadcast, music, video or film industries" (brief, p. 4); and that partial cancellation of the registration is appropriate to ensure that the registration accurately reflects respondent's rights in the mark.[11]

The problem with petitioner's position in this case is that the sparse evidence before us does not establish

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claim of abandonment, or as one based on a claim for restriction of a registration to avoid likelihood of confusion, in the context of the Eurostar case, makes virtually no difference because of petitioner's failure of proof.

For a discussion of the Eurostar case, see 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §20:44 (4th ed. 2000).

[11] In the petition to cancel petitioner requested that the registration be cancelled as to "software sold in the broadcast, music, video and film industries." In its brief on the case petitioner requested respondent's identification of goods be restricted to read either (i) "computer programs, excluding programs for use in the broadcast, music, video and film industries"; or (ii) "computer programs that generate spreadsheets, function as desktop and personal information managers, and perform computer utility functions"; or (iii) "computer programs, excluding programs for facilitating the

abandonment of the mark LUCID by respondent; and, to the contrary, it establishes that respondent uses its mark on a variety of computer software sold in various channels of trade, including the broadcast, music, video or film industries. For example, reproduced below are some of petitioner's discovery requests, and respondent's answers thereto (made of record by petitioner):

> (1) First Set of Interrogatories, No. 8 - Identify each and every customer in the broadcast, video, film, and music industries to whom Registrant has sold computer software in association with the trademark LUCID.
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> Answer – Registrant will make available to petitioner its business records from which an answer to this interrogatory may be derived or ascertained. Such records include registration cards, computer database(s), and other similar accounting records. Also, attached is Exhibit A that represents a computerized summary of certain responsive customers from 1992 to 1996;[12]
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> (2) Second Set of Interrogatories, No. 1 – Identify at least three customers in the broadcast, video or music industries to whom Registrant has sold computer software in association with the trademark LUCID for each of the

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transfer of audio signals into a computer for manipulation of the audio signals in a post-production environment."

[12] Exhibit A is titled "Partial Customer List" and includes entities such as Walt Disney World Co., Westwood Studio, Yankee Music, Jetstream Video Inc., WNOW Radio and Jewish Voice Broadcasts.

calendar years from 1987 to the present date.

Answer – Records are no longer maintained that would make such identification possible. Most of the products bearing the LUCID trademark are sold through distributors and retailers to the general public and a broad spectrum of businesses and industries including the broadcast, video and music industries;

(3) Second Set of Interrogatories, No. 2 – For each of the sales identified in response to the preceding interrogatory, identify all documents and things that support Registrant's allegation that it has sold the identified customer software in association with the trademark LUCID.

Answer – See answer to Interrogatory No. 1 above. However, nothing known to Registrant would give Registrant cause to believe that the pattern shown by the 1993 and 1994 data has changed and that sales to members of the broadcast, video and music industries continue on a regular basis; and

(4) Request for Admission No. 2- Admit that the Registrant has not produced any evidence to show use of the mark LUCID in association with the sale of software in the broadcast, video or film industries during the calendar years 1987, 1988, 1989, 1990, 1991, 1992, 1995, 1996, 1997 and 1998.

Answer – Denied. Additionally, the documents informally requested by Petitioner's attorney, produced herewith, evidence products sold to a vast array of businesses and industries, including broadcast, video and film industries.

The fact that respondent's discovery responses do not show use on certain specific type(s) of computer program(s) does not establish abandonment of the mark for the goods as identified in the registration by respondent. In view of petitioner's failure to prove abandonment of the mark by respondent, either in whole or with respect to the broadcast, video, film or music industries, the petition to cancel must fail.

Decision: The petition to cancel (including petitioner's alternative request for partial cancellation) is denied.

R. L. Simms

B. A. Chapman

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board